

REMARKS

Applicant appreciates the thorough examination of the present application as evidenced by the Office Action of August 25, 2006. Applicant has amended independent Claims 1, 7, 14 and 22 to further highlight patentable distinctions over references cited in the Office Action. In particular, the recitations of dependent Claims 2 and 4, 8 and 10, 15 and 17 and 23 and 25 have been incorporated into independent Claims 1, 7, 14 and 22, respectively, and dependent Claims 2, 4, 8, 10, 15, 17, 23 and 25 have been cancelled from the present application. Claims 3, 5, 9, 11-13, 16 and 24 have been amended to conform the dependencies thereof to the cancellation of Claims 2, 4, 8, 10, 15, 17, 23 and 25. Applicant has also added new Claims 31-36. Applicant respectfully submits that the pending claims are in condition for allowance for at least the reasons discussed herein.

The Section 102 Rejection

Claims 1-3, 6-9, 12-15, 18, 20-24, 26 and 28-30 stand rejected under 35 U.S.C. § 102(b) as being anticipated by United States Patent No. 5,335,368 to Tamura (hereinafter "Tamura"). *See* Office Action, page 2. Applicant respectfully submits that many of the recitations of Claims 1-36 are neither disclosed nor suggested by the cited references. For example, amended Claim 1 recites:

A portable electronic device, comprising:
a housing;
an antenna associated with the housing; and
a multi-mode matching circuit operatively associated with the antenna, the multi-mode matching circuit being configured to operate in a first mode when the housing of the portable electronic device is in a first configuration and in a second mode when the housing of the portable electronic device is in a second configuration;
a sensor operatively associated with the multi-mode matching circuit, wherein the sensor is configured to detect the first configuration of the housing of the portable electronic device and/or the second configuration of the housing of the portable electronic device and wherein the multi-mode matching circuit is configured to adjust at least one parameter of the multi-mode matching circuit responsive to the first and/or second detected configurations of the housing of the portable electronic device, and **wherein the at least one parameter is stored in a lookup table; and**
a processor operatively associated with the sensor, the processor being configured to locate the at least one parameter in the lookup table using the first and/or second detected configuration of the housing of the portable electronic device as a pointer for an entry in the lookup table.

Independent Claims 7, 14 and 22 include similar recitations to the highlighted recitations of amended Claim 1. Applicant respectfully submits that at least the highlighted recitations of amended Claim 1 are neither disclosed nor suggested by any of the cited references, either alone or in combination, for at least the reasons discussed herein.

In particular, the Office Action admits with respect to Claims 4, 10, 17 and 25, the recitations of which have been incorporated into independent Claims 1, 7, 14 and 22, respectively, that "Tamara does not expressly disclose at least one parameter is stored in a lookup table." See Office Action, page 6. However, the Office Action points to Kim as providing the missing teachings. See Office Action, page 6. In particular, the Office Action, states:

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate utilizing lookup table for adjusting matching circuit taught by Kim inot [sic] the portable electronic device and method of Tamura, in order to provide more accurate auto adjustment to match the impedance.

See Office Action, page 7. Applicant respectfully disagrees.

Applicant respectfully submits that there is no motivation or suggestion to combine the cited references as suggested in the Office Action. As affirmed by the Court of Appeals for the Federal Circuit in *In re Sang-su Lee*, a factual question of motivation is material to patentability, **and cannot be resolved on subjective belief and unknown authority**. See *In re Sang-su Lee*, 277 F.3d 1338 (Fed. Cir. 2002). It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 U.S.P.Q. 303, 312-13 (Fed. Cir. 1983).

The motivation provided in the Office Action set out above is, at most, a motivation based on "subjective belief and unknown authority," the type of motivation that was rejected by the Federal Circuit in *In re Sang-su Lee*. In other words, the Office Action does not point to any specific portion of the cited references that would induce one of skill in the art to combine the cited references as suggested in the Office Action. If the statement in the Office Action were adequate to sustain the Office's burden, then anything that would provide "provide more accurate auto adjustment to match the impedance" would be rendered obvious. This cannot be the case. Accordingly, the statement in the Office Action with respect to motivation does not adequately address the issue of motivation to combine as discussed in *In re Sang-su Lee*. Thus, it appears that the Office Action gains its alleged impetus or

suggestion to combine the cited references by hindsight reasoning informed by Applicant's disclosure, which, as noted above, is an inappropriate basis for combining references. Accordingly, Applicant respectfully submits that Claim 1 and the claims that depend therefrom are patentable over the cited combination for at these reasons.

Furthermore, one of skill in the art would not be motivated to use a lookup table in combination with the teachings of Tamura as Tamura only discusses two configurations of the mobile terminal – open and closed (Figures 5 and 6) or up and down (Figures 7 and 8). Thus, the parameters could be programmed into the phone and would not require a lookup table. In stark contrast, some embodiments of the present invention discuss three or more configurations of the portable electronic device as illustrated by, for example, the table of Figure 4. Thus, a lookup table including the parameters for each of the three or more configurations may be useful. Accordingly, Applicant respectfully submits that Claim 1 and the claims that depend therefrom are patentable over the cited combination for at these additional reasons.

Claims 7, 14 and 22 contain similar recitations to the highlighted recitations of Claim 1 set out above and, therefore, Applicant respectfully submits Claims 7, 14 and 22 and the claims that depend therefrom are patentable over the cited combination for at least the reasons discussed above with respect to Claim 1.

The Dependent Claims

Claims 5, 11, 19 and 27 stand rejected under 35 U.S.C. § 103 as being unpatentable over Tamura in view of United States Patent Application Publication No. 2003/0144031 to Ono *et al.* (hereinafter "Ono"). *See* Office Action, page 5. Claims 4, 10, 17 and 25 stand rejected under 35 U.S.C. § 103 as being unpatentable over Tamura in view of United States Patent No. 6,862,432 to Kim (hereinafter "Kim"). *See* Office Action, page 6. The recitations of Claims 4, 10, 17 and 25 have been incorporated into independent Claims 1, 7, 14 and 22, respectively, which are patentable over the cited referenced for at least the reasons discussed above. The remaining dependent claims are patentable at least per the patentability of the independent base claims from which they depend.

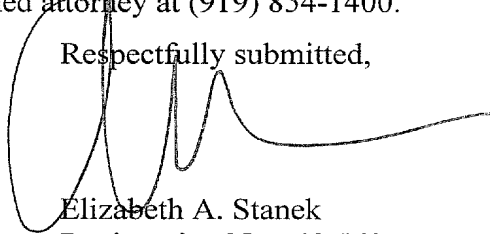
New Claims 31-36 are patentable over the Cited References

Applicant has added new Claims 31-36 to the present application reciting various details of the present invention. For example, new independent Claim 31 specifically recites that the portable electronic device has at least three modes. Furthermore, new independent Claim 35 specifically recites that the portable electronic device has a jack-knife configuration. This aspect of the present invention is also recited in new dependent Claim 32. New dependent Claim 34 further recites a camera device protruding from the portable electronic device that causes different configurations of the camera. Applicant respectfully submits that the new claims are patentable over the cited references as the cited references do not disclose or suggest many of the recitations of the new claims.

CONCLUSION

In light of the above discussion, Applicant submits that the present application is in condition for allowance, which action is respectfully requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (919) 854-1400.

Respectfully submitted,




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Erin C. Dutton